

**Translation**

**PATENT COOPERATION TREATY**

**PCT**

**INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY**  
(Chapter II of the Patent Cooperation Treaty)

(PCT Article 36 and Rule 70)

|   |   |   |
|---|---|---|
| Applicant's or agent's file reference<br><b>DPA5240PT-WO</b>                  | FOR FURTHER ACTION<br>See Form PCT/IPEA/416                     |   |
| International application No.<br><b>PCT/DE2004/000894</b>                     | International filing date (day/month/year)<br><b>29.04.2004</b> | Priority date (day/month/year)<br><b>28.05.2003</b> |
| International Patent Classification (IPC) or national classification and IPC: |   |   |
| Applicant<br><b>DEUTSCHE POST AG</b>  |   |   |

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|--|--|
| <p>1. This report is the international preliminary examination report, established by this International Preliminary Examining Authority under Article 35 and transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of <u>11</u> sheets, including this cover sheet.</p> <p>3. This report is also accompanied by ANNEXES, comprising:</p> <p>a. <input checked="" type="checkbox"/> (sent to the applicant and to the International Bureau) a total of <u>10</u> sheets, as follows:</p> <p><input checked="" type="checkbox"/> sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications authorized by this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions).</p> <p><input type="checkbox"/> sheets which supersede earlier sheets, but which this Authority considers contain an amendment that goes beyond the disclosure in the international application as filed, as indicated in item 4 of Box No. I and the Supplemental Box.</p> <p>b. <input type="checkbox"/> (sent to the International Bureau only) a total of (indicate type and number of electronic carrier(s)) _____, containing a sequence listing and/or tables related thereto, in computer readable form only, as indicated in the Supplemental Box Relating to Sequence Listing (see Section 802 of the Administrative Instructions).</p> |  |
| <p>4. This report contains indications relating to the following items:</p> <p><input checked="" type="checkbox"/> Box No. I Basis of the report</p> <p><input type="checkbox"/> Box No. II Priority</p> <p><input type="checkbox"/> Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability</p> <p><input type="checkbox"/> Box No. IV Lack of unity of invention</p> <p><input checked="" type="checkbox"/> Box No. V Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability: citations and explanations supporting such statement</p> <p><input type="checkbox"/> Box No. VI Certain documents cited</p> <p><input type="checkbox"/> Box No. VII Certain defects in the international application</p> <p><input type="checkbox"/> Box No. VIII Certain observations on the international application</p>  |  |

|   |                                   |
|---|-----------------------------------|
| Date of submission of the demand        | Date of completion of this report |
| Name and mailing address of the IPEA/EP | Authorized officer                |
| Facsimile No.                           | Telephone No.                     |

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Box No. 1

## Basis of the report

1. With regard to the language, this report is based on the international application in the language in which it was filed, unless otherwise indicated under this item.
- ☐ This report is based on translations from the original language into the following language \_\_\_\_\_ which is the language of a translation furnished for the purposes of:
- ☐ international search (Rule 12.3 and 23.1(b))
- ☐ publication of the international application (Rule 12.4)
- ☐ international preliminary examination (Rule 55.2 and/or 55.3)
2. With regard to the elements of the international application, this report is based on *(replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report)*:
- ☐ the international application as originally filed/furnished
- ☒ the description:
- pages 1, 2, 4-22 \_\_\_\_\_ as originally filed/furnished
- pages\* 3, 3a \_\_\_\_\_ received by this Authority on 29.03.2005 with
- pages\* \_\_\_\_\_ received by this Authority on telefax
- ☒ the claims:
- nos. \_\_\_\_\_ as originally filed/furnished
- nos.\* \_\_\_\_\_ as amended (together with any statement) under Article 19
- nos.\* 1-27 \_\_\_\_\_ received by this Authority on 29.03.2005 with
- nos.\* \_\_\_\_\_ received by this Authority on telefax
- ☒ the drawings:
- sheets 1/2-2/2 \_\_\_\_\_ as originally filed/furnished
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- sheets\* \_\_\_\_\_ received by this Authority on \_\_\_\_\_
- ☐ a sequence listing and/or any related table(s) - see Supplemental Box Relating to Sequence Listing.
3. ☐ The amendments have resulted in the cancellation of:
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_
4. ☐ This report has been established as if (some of) the amendments annexed to this report and listed below had not been made, since they have been considered to go beyond the disclosure as filed, as indicated in the Supplemental Box (Rule 70.2(c)).
- ☐ the description, pages \_\_\_\_\_
- ☐ the claims, nos. \_\_\_\_\_
- ☐ the drawings, sheets/figs \_\_\_\_\_
- ☐ the sequence listing (specify): \_\_\_\_\_
- ☐ any table(s) related to sequence listing (specify): \_\_\_\_\_

\* If item 4 applies, some or all of those sheets may be marked "superseded."

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**Box No. V** Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability:  
citations and explanations supporting such statement

## 1. Statement

|                               |                    |     |
|-------------------------------|--------------------|-----|
| Novelty (N)                   | Claims <u>1-27</u> | YES |
|                               | Claims _____       | NO  |
| Inventive step (IS)           | Claims _____       | YES |
|                               | Claims <u>1-27</u> | NO  |
| Industrial applicability (IA) | Claims <u>1-27</u> | YES |
|                               | Claims _____       | NO  |

## 2. Citations and explanations (Rule 70.7)

**PCT Article 19(2) (b)**

1. The requirements of PCT Article 19(2) (b) are met:

1.1 In claim 1, the expression "in the form of a postal address" has been added to the term "address information" in the first characterising feature. This amendment is supported by page 13, lines 23-30, of the original disclosure.

The applicant has further added the following specifications to the last characterising feature:

"the billing component (91) of the mailing system (10) charges a billing component (93) of the mobile system (11) for the printing and/or postal costs."

This amendment is supported by the original dependent claim 6.

In independent claim 24, the phrase "for charging the billing component (93) of the mobile system

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(12) for the printing and postal costs" has been added to the feature of the "billing component (91)" in order to further characterise it.

This amendment is supported by page 6, lines 14-27, of the original disclosure.

The original claims 3 and 6 have been deleted.

2. This report makes reference to the following documents, which have already been cited in the written opinion issued by the International Searching Authority:

D1: US 5 805 810 A

D2: US 2002/0132609 A

3. The present application does not meet the requirements of PCT Article 33(1) because the subject matter of independent claims 1 and 24 does not involve an inventive step (PCT Article 33(3)).

- 3.1 Document D1 is considered to constitute the prior art closest to the subject matter of claim 1 and discloses (the references in parentheses are to that document):

- a process for automatically commissioning and executing printing and postal services within a mailing system, in which the commissioning data for printing and mailing a postal object are

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generated by a terminal (column 1, lines 9-17; and column 4, lines 20-23: "The email messages may be sent by any computer user with access to the Internet", the computer of the user corresponding here to the terminal), the process having the following steps:

- commissioning data are generated by a terminal and include at least graphic information and address information in the form of a postal address (the terminal, as explained above, corresponds to the computer of the user; column 4, lines 24-29: "Email messages may include text, graphics and attachments (including text alone, graphics alone, or combinations of text and graphics)"; address information include, *inter alia*, an indication of the addressee; see column 4, lines 30-42);
- the commissioning data are checked and processed in the checking and processing component and transmitted to an interface of the mailing system (as indicated on page 14, lines 18-18, the checking and processing component can optionally belong to various systems, including, *inter alia*, a mailing system. In this report, it is assumed that the checking and processing component is part of the mailing system, i.e. postal system. In D1, the "message validator 22" checks whether the email format is suitable for conversion into postal mail; see column 10, lines 5-14; moreover, the "message validator" extracts sender and recipient data from the

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email, i.e. processes the email. Consequently, the checking and processing component can be considered to be the same as the message validator);

- the commissioning data are transmitted from the interface to a data base ("sender database 1300" and "recipient database 1400" in column 9, lines 6-62), are processed in a processing component connected to the data base to produce a printing commission (column 10, lines 43-48), the printing commission is transmitted to a printing unit, and a postal mail is generated in the printing unit (column 12, lines 55-67),
- the postal mail is handed over to a distribution system (since the system described in D1 produces postal mail, it is considered in any case as implicitly disclosed that the postal mail is forwarded to a distribution system), and
- the printing and/or postal costs are charged by a billing component of the mailing system (the "message validator" debits postage from the customer's credit; see column 13, lines 28-31).

3.2 The amended claim 1 contains the following differentiating features which are not contained in D1:

- (i) the terminal is a mobile terminal belonging to a mobile system;
- (ii) the commissioning data are transmitted by the mobile terminal to a processing component of the mobile system;

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(iii) the commissioning data are transmitted by the processing component of the mobile system to the checking and processing component.

The following differentiating feature is also not contained in D1:

(iv) the billing component of the mailing system charges a billing component of the mobile system for the printing and/or postal costs.

3.3 Features (i) to (iii), as well as (iv), have two different effects:

- the differentiating features (i), (ii) and (iii) have the technical effect of making data communication within the system disclosed in D1 more flexible;
- feature (iv) has the effect of modifying the billing mode.

3.4 The same argument, which has already been put forth in the written opinion issued by the International Searching Authority, applies to features (i) to (iii), i.e.

proceeding from D1, a person skilled in the art would have faced the realistic problem of how to design a more flexible mailing system.

In particular, wireless connections, by means of which access to the internet can be established, were known from daily practice long before the

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priority date of the present application.

Consequently, it would be an obvious aim for a person skilled in the art, on the basis of his daily experience, to extend the process described in document D1 to wireless communication appliances (such as PDA and mobile telephones) as well.

D2, for example, describes such an extension of a conventional network to wireless communication. It describes a mobile terminal within a mobile system ("wireless device 20" in a "wireless network 16"; see page 2, paragraph 25). An email is transmitted by the mobile terminal to a "wireless transmitter 18", then forwarded over a wireless network through a gateway (see page 3, paragraph 33; this is identified with the processing component of the mobile system) in a conventional WAN/LAN; see page 2, paragraph 31.

The teaching disclosed in D2 can be obviously applied to D1. The commissioning data are then transmitted by the mobile terminal ("wireless device 20") to the checking and processing component (which corresponds to the "message validator 22" in D1, as explained above) via the processing component ("Gateway Services 32"; see figure 1 in D2).

The additional features of claim 1 which go beyond the subject matter of D1 therefore do not involve an inventive step.



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3.5 As relates to feature (iv), it should be noted that this differentiating feature relates to a business activity. The problem addressed by this differentiating feature is supposed to be that of permitting a third party (such as a fixed network telephone company, an internet service provider or a mobile radiotelephone operator) to take over billing for the service from the mailing system.

It should be noted that the differentiating feature does not make a contribution to the solution of a technical problem, besides the mere automation of a business activity. This feature is irrelevant to the assessment of inventive step.

Should the applicant argue that including the differentiating feature in the printing service process known from D1 requires solving a technical problem, the examiner would reply that the only recognisable problem in the teaching of D1 is that of modifying the process known from D1 in such a way that the business activity defined in the differentiating feature can be carried out.

A person skilled in the art facing the problem of permitting the business activity (the transfer of billing and the concomitant transfer of billing data to a third party) within the framework of the process described in D1 (this problem is raised by a person without technical training), would discover that the process and system disclosed in

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D1 include all the technical features (computer, data base with entries regarding the amounts to be paid by the users, network) necessary to include the business activity which constitutes the differentiating feature in the process described in D1. For a person skilled in the art, this adaptation of the process described in D1 is an obvious aim which he would attain without needing an inventive step.

Even after the differentiating feature (iv) is implemented in the process described in D1, the technical features of D1 continue to operate with their well-known function, without leading to a surprising (synergistic) effect.

The solution proposed in claim 1 of the present application therefore cannot be considered inventive (PCT Article 33(3)).

4. An analogous argument applies to the independent system claim 24, whose features (mobile terminal, mobile system, mailing system, etc.) correspond to the features of the independent process claim 1.
5. Dependent claims 2-22 and 25-27, as well as independent claim 23 (a system claim that has been drafted as a claim dependent on method claims) do not contain any features which, in combination with the features of any claim to which they refer, meet the PCT inventive step requirements; see documents D1 and D2, the corresponding

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passages indicated in the search report, as well  
as the observations in the written opinion issued  
by the International Searching Authority.